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TRANSMITTAL LETTER
(General - Patent Pending)

Docket No.
0EKM-080279

In Re Application of: Joseph H. Hoffman et al.

Serial No.
09/881,361

Filing Date
06/13/2001

Examiner
Stephen Luther Blau

Group Art Unit
3711

Title: **GOLF CLUB AND METHOD FOR MAKING IT**

TO THE DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE:

Transmitted herewith is:

Appellants' Reply to Examiner's Answer

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Dated: July 21, 2003

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PATENT

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 09/881,361 Confirmation No. 8740
Applicants : Joseph H. Hoffman et al.
Filed : June 13, 2001
TC/A.U. : 3711
Examiner : Stephen Luther Blau

Docket No. : 0EKM-080279
Customer No. : 30764

APPELLANTS' REPLY TO
EXAMINER'S ANSWER

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Mail Stop Appeal Brief- Patents
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Alexandria, VA 22313-1450

Sir:

This brief is submitted in reply to the Examiner's Answer, filed
May 20, 2003.

I. GROUPING OF CLAIMS

In paragraph 7 of the Answer, the Examiner disagreed with the grouping of the claims, asserting that claim 1 was excluded from issue A.

In response, Appellants assert that claim 1 is to be included in the grouping of claims for issue A. (See, Appellants' Brief, pages 3-4.)

II. DEFICIENCIES IN THE EXAMINER'S ANSWER

A. **New Grounds of Rejection in the Examiner's Answer**

In the Examiner's Answer to the Appellants' Brief, the Examiner offers new grounds of rejection based upon the same references.

First, in support of all rejections, the Examiner, for the first time, now relies upon Kochevar as disclosing "a binder containing a polymeric material in the form of polyisobutylene which is compliant in that it can be compressively loaded and is deformable without need to deform a plug from a substantial shape." (Answer, pages 4-5)

Second, the Examiner now dismisses WO '873, as an "accumulative reference . . . and has been kept in the rejection for completeness though it was not really needed." (Id., page 11, ¶ 9; see also, Id., page 12, ¶¶ 11, 12.) Yet, the Examiner continues to rely upon WO '873, in the grounds of rejection to "modify the club of [JP '355] to have a binder being a compliant polymeric material compression fitted into the hosel cavity by slight compression without a need of deforming the plug from its substantial shape . . ." (Id., page 5)

The Appellants address the new grounds of rejection and new arguments regarding WO '873, for the first time, below.

B. **Examiner's New Interpretation of Kochevar Fails to Cure the Defect of the Examiner's Rejections**

The Examiner continues to use the cited references as a catalog of materials to reconstruct the Appellants' invention without proper consideration for the invention as a whole. As mentioned above, the Examiner now replaces his previous recitation for polymeric

material with polyisobutylene, as disclosed in Kochevar. However, as explained below, the prior art, as asserted by the Examiner in the new grounds of rejection fails, or even, suggest a golf club, and related method of making it, having all of the features of claimed invention, including hosel plug of a mixture of a metallic powder and a compliant polymeric material ✓ secured in place by compression of its compliant polymeric material.

In contrast, Kochevar discloses a weight capsule (10) having a deformable sheath and permanently deformable mass (13) configured in a mixture to provide a putty-like consistency. *See col 3, lines 25-50.* In the exemplary embodiment, polyisobutylene is included in the mass for its sticky, adherent qualities:

"If it is desired that the mass 13 have adhering qualities, it should also contain a sticky or adherent material. One such material is polyisobutylene. The material added to provide adhering quality also serves as a binder in that it tends to hold the particulate material together."

(Col. 5, lines 51-56)

These attributes of polyisobutylene are further utilized by Kochevar to adhere the weight capsule to the walls of the cavity (39), thereby holding the capsule in place.

During installation, a ram (41) is used to compress the capsule. The ram is inserted through the shaft (33) of the club head to apply axial compression on to the capsule of sufficient force deform and/or rupture the sheath, causing permanent deformation the weight capsule and allowing the mass (13) to extrude from the sheath, adhering to the cavity. (Col. 4, lines 24-56.) Once this installation step has been completed and the compressive force has been removed, the capsule is secured in place, in the resultant golf club, simply by its permanently deformed shape and its sticky, adherent qualities:

In the embodiment illustrated, the mass has a relatively adherent quality so that it tends to stick to the walls of the cavity. This further tends to hold the deformed weight capsule in the cavity. The deformed capsule automatically tends to be retained in the cavity 39 merely as a result of the deformation or extrusion of the weight capsule, no separate capsule attaching step is necessary."

(col. 4, lines 38-46)

Thus, the new grounds for rejection fail to disclose, or even, suggest a golf club, and related method of making it, having all of the features of claimed invention, including hosel plug of a mixture of a metallic powder and a compliant polymeric material secured in place, in the golf club, by compression of its compliant polymeric material.

For these reasons, the obviousness rejections, based upon the new grounds for rejection, are improper. Appellants respectfully urge the Board to reverse these rejections.

C. Examiner's Dismissal of WO '873, as an Accumulative Reference, Cannot be Used to Circumvent Requirement of Providing a Suggestion or Motivation to Combine or to Consider a Reference in its Entirety.

As mentioned above, the Examiner now dismisses WO '873, as an "accumulative reference," and yet continues to rely upon it in combination with JP '355 and Kochevar. More particularly, the Examiner continues to WO '873, in the catalog of materials found in the references, as disclosing "a compliant polymeric material compression fitted into the hosel cavity by slight compression without a need of deforming the plug from its substantial shape . . ." (Id., page 5)

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Nonetheless, the Examiner fails to fully respond to Appellants' request of providing a suggestion, or motivation, from the prior art of combining WO '873 with Kochevar. Rather, Examiner merely asserts the following:

"The argument that it is improper to combine the references of WO '973 and Kochevar since it would cause it to lose its putty like consistency is disagreed with. Kochevar and WO '873 were used to show different binders. The deformable non-putty-like binder of WO '873 is a suitable substitute of the deformable binder of Kochevar."

(Answer, page 9)

In short, the Examiner continues to list materials found in the references, simply substituting one for another until Appellants' invention has been replicated. This approach fails to provide a suggestion, or motivation, for combining that accounts for the entire teaching of each reference, as is required.

Moreover, the Examiner assertion that WO '873 is "not really needed," now makes unclear the grounds for rejecting claims 17-19, as the language of those claims is only recited by the Examiner in association with WO '873.

For these reasons, and for the reasons asserted in the Appellants's Brief, the obviousness rejections based upon WO '873, if any, are improper. Appellants respectfully urge the Board to reverse these rejections.

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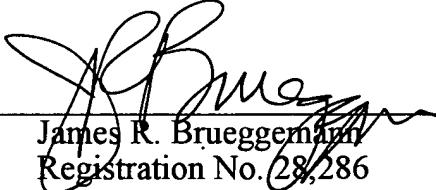
III. CONCLUSION

For the reasons stated in Appellants' Brief, supplemented by the reasons set forth above, the rejections under appeal are improper and should be reversed. A decision directing the Examiner to issue a Notice of Allowance is respectfully requested.

Respectfully submitted,

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